

In re: Malcom B. Strandberg
Filed: September 28, 1998
Serial No.: 09/161,816
Page 2

REMARKS

Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks.

Claims 1, 13, 22, 29, 30, 32 and 35 had been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written restriction requirement. The Examiner states that the claims contain subject matter that is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the Examiner states that element/location 14c of FIG 3 of Applicant invention supports simultaneous voice in data communications. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the Examiner has misinterpreted 35 U.S.C. § 112, first paragraph, and/or misunderstood the present invention. Applicant directs the Examiner's attention to at least page 17 of the present application as originally filed which states, in relevant part,

For a "dial up" type connection, the same telephone line 84

In re: Malcom B. Strandberg

Filed: September 28, 1998

Serial No.: 09/161,816

Page 3

is typically used by both the telephone 78 to receive calls and the computer terminal 74 to access the global computer network 62. Thus, the telephone line 84 may not be available for a call back to the telephone 78 if the telephone line 84 is still in use to access the global computer network 62. (Emphasis added.)

Additionally, Applicant directs the Examiner's attention to at least page 3-4 of the present application as originally filed which states, in relevant part,

Providing an immediate connection to an agent, however, presents an additional problem. One common way to connect to the Internet / World Wide Web is by using a PC with a modem that dials in to an Internet Service Provider (ISP) over the Public Switched Telephone Network (PSTN). If the only available telephone line is being used for connecting to the network, an immediate call back may not be possible since the inquiring party is likely to still be connected to the network (i.e., "on-line") when the attempted call back is made. When dialing outbound calls, existing telephony systems will typically treat a busy signal as a failed attempt and will schedule a recall at a later point in time. Thus, the inquiring party will not receive the assistance as soon as possible after the request has been made.

Applicant respectfully submits that at least the above-cited sections clearly provide support for the claims as previously amended.

While Applicant agrees that the present application describes embodiments wherein simultaneous voice and data communications are possible, Applicant respectfully submits that this does not

preclude Applicant from claiming an embodiment described and fully supported in the application, as originally filed, wherein simultaneous voice and data communications are not possible. Additionally, Applicant submits that the test is not whether location 14c *could* be modified to support both simultaneous voice in data communications. To conclude otherwise is simply a misinterpretation of 35 U.S.C. § 112, first paragraph.

For at least the above reasons, Applicant respectfully submits that the rejection of claims 1, 13, 22, 29, 30, 32 and 35 under 35 U.S.C. § 112, first paragraph, is improper and should be withdrawn.

Claims 1, 4-11, 21-23, 26, and 29-33 had been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,032 (Bateman et al.) in view of U.S. Patent No. 4,052,570 (Sutton). Applicant respectfully traverses this rejection.

At the outset, Applicant respectfully submits that statements made by the Examiner in the present office action appear to contradict each other. For example, in the rejection under 35 U.S.C. § 112, first paragraph, the Examiner states, in relevant part, "Looking at element/location 14c of Fig. 3 of applicant's invention, simultaneous support of both voice and data

communications are possible." (*Emphasis added.*) However, the Examiner then states in the rejection under 35 U.S.C. § 103(a), in relevant part, "In this set up, at the outset of Internet communications and even now, when dial up connections are used to connect to the Internet, it is not possible for both voice and data to be simultaneously supported, where both a telephone and computer are being used to effect a voice and data communications respectively. Only one type of communication will be supported at any one time on a standard analog telephone line." (*Emphasis added.*) Applicant respectfully submits that these two statements appear to contradict each other.

Additionally, Applicant respectfully submits that the Examiner appears to misunderstand the technology. For example, in the rejection under 35 U.S.C. § 103(a) (paragraph 3), the Examiner states, "Only one type of communication will be supported at any one time on a standard analog telephone line." Additionally, in the RESPONSE TO ARGUMENTS section (paragraph 5), the Examiner states,

At the outset of Internet use, modems, such as modem 122 of Bateman et al., were used to allow dial up connections to the Internet over an analog line. At this time, simultaneous support of voice and data, i.e., voice over a POTTS telephone and data over a computer, were not possible.

Even today, standard telephone lines cannot support both voice and data in this manner. If one is connected to the Internet over a dial connection, one must still disconnect from the Internet to use a telephone connected to the same line. (*Emphasis added.*)

Applicant submits that these statements are simply incorrect and inaccurate, and appear to contradict the Examiner's later statements regarding SVD modems. Applicant submits that at the time Bateman et al. was filed, as well as the present, the use of an SVD modem (simultaneous voice/data) for analog POTTS lines was well known. The Examiner also appears to acknowledge this statement. For example, the Examiner then states,

While Bateman et al. does contemplate embodiments of the invention wherein data invoice can simultaneously be supported, such would only be possible with an SVD/ISDN unit 216 (Fig. 10) and/or if the one line is an ISDN line which may support both voice and data simultaneously."

While not clear, Applicant is not sure if the Examiner is interpreting this statement to mean that an SVD modem must be used with an ISDN line. If this interpretation is correct, Applicant respectfully submits that this is incorrect. If this interpretation is not correct, Applicant respectfully submits that the Examiner's statement contradicts several previous statements stating that simultaneous support of both voice/data over a POTTS

line is not possible.

In either event, Applicant respectfully submits that the embodiment shown in FIG 8 of Bateman et al. DOES support both voice and data simultaneously. In the RESPONSE TO ARGUMENTS section (paragraph 5), the Examiner states,

Therefore, even if Bateman et al. intended for simultaneous voice and data communications by using the second modem 126 seen in Fig. 8, it would have been obvious that if a second modem was not available, operation of the system would be as that claimed by the present invention. Also, while an argument can be made that Bateman et al. teaches using two separate modems, in earlier times, and even in present times, a customer using two modems between one computer in one telephone is highly unlikely. (*Emphasis added.*)

Applicant respectfully disagrees with the above statements. Firstly, Applicant respectfully submits that not only *can an argument* be made that Bateman et al. teaches using two separate modems in the embodiment shown in FIG 8 as suggested above by the Examiner, but also that this is the only argument that can be made. Referring specifically to FIG 8, the use of a first and second modem 122, 126 is clearly shown. This is irrefutable. Moreover, column 9, lines 54-58 of Bateman et al. discloses, "This embodiment provides a method for integrating or connecting a customer 100 who had a telephone 120, 8 PC 124 with DDE (dynamic

data exchange) capabilities and two modems 122, 126 and lines 127, 128 and wishes to be connected to a line agent 104." This is the only part of Bateman et al. reference in the embodiment shown in FIG eight. Accordingly, there is no support in Bateman et al. for the proposition of an embodiment shown in FIG 8 having only a single modem. To conclude otherwise is simply a misinterpretation of Bateman et al. and requires impermissible hindsight reasoning.

Additionally, Applicant respectfully submits that the embodiment shown in FIG 8 does not include a data terminal and a telephone both connected to a telephone line as claimed in the independent claims, but rather discloses an embodiment wherein the data terminal is connected to a first line and the telephone is connected to a second line. Referring specifically to FIG 8, it can be seen that computer 124 is connected to line 128 and that telephone 120 is connected to line 127. Though not explicitly described in the specification, line 125 connecting computer 124 to modem 122 is clearly present to allow computer 124 to automatically dial modem 122. This is supported in Bateman et al. on column 9, lines 59-64, "In this embodiment, the PC 124 is equipped with communications software and modems 122, 126 able to place the call between the customer's telephone 120 and the ACD

agent itself, automatically, instead of requiring the telephone switch to set up the call as in FIG. 6." This is the purpose of the DDE that the Examiner refers to in the present office action.

In the embodiment shown in FIG 8, it is clear that data is transmitted over line 128 to PC 124 while voice is transmitted over line 127 to telephone 120. Accordingly, the customer premises shown in FIG 8 is capable of simultaneously supporting both voice and data. Applicant further submits that this interpretation is supported by Bateman et al. since the stated purpose of Bateman et al. is to provide a series of methods for integrating the WWW services with live ACD agents including the establishment of two-way voice conductivity between a customer and a human ACD agent while sharing common screens of information on a WWW page. See column 2, lines 22-26.

Any interpretation that the embodiment shown in FIG 8 does not support both voice and data simultaneously would contradict the stated purpose of Bateman et al. since the customer and human ACD agent could not share common screens of information on a WWW page while simultaneously having a voice conversation. Moreover, any modification suggested by the Examiner to alter the embodiment shown in FIG 8 to include only a single modem is improper since it

would render the embodiment unsatisfactory for its intended purpose.

Accordingly, Applicant respectfully submits that the embodiment shown in FIG 8 does support voice and data simultaneously. Therefore, Applicant respectfully submits that Bateman et al. does not disclose or suggest the limitation that of having a first location that does NOT support voice and data simultaneously as recited in the independent claims of the present application. For the reasons discussed in the previous responses, Applicant submits that none of the other embodiments disclosed in Bateman et al. disclose or suggest these limitations. Thus, Applicant submits that the rejection of the pending claims under 35 U.S.C. § 103(a) as being obvious in view of the combination of Bateman et al. and Sutton is improper and should be withdrawn. Reconsideration and allowance is respectfully requested.

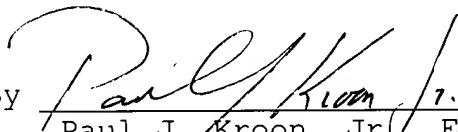
The Examiner is invited to telephone the undersigned,

In re: Malcom B. Strandberg
Filed: September 28, 1998
Serial No.: 09/161,816
Page 11

applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

Malcom B. Strandberg

By 
Paul J. Kroon, Jr., Esq.
Registration No. 51,902
Attorney for Applicant

BOURQUE & ASSOCIATES, P.A.
835 Hanover Street, Suite 301
Manchester, New Hampshire 03104

Telephone: (603) 623-5111
Facsimile: (603) 624-1432

Date: Oct. 19, 2004